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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,705	11/07/2000	Kenji Sakamoto	IKU0104PUSA	2404

7590

03/01/2005

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EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/647,705	Applicant(s) SAKAMOTO, KENJI	
	Examiner Suryaprabha Chunduru	Art Unit 1637	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 03 February 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.


JEFFREY FREDMAN
PRIMARY EXAMINER

2/23/05

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments have been fully reviewed and found unpersuasive. Applicants argue that the prior art of record (Ali et al.) does not anticipate the instant claim 1 because Ali et al. did not teach synthesis of a peptide having at least 70% homology. Applicants' further argue that the Fig. 4 of the disclosure of Ali et al. is merely a schematic representation of different prolactin receptors and does not mention the synthesis of said peptides. Applicants' arguments are fully considered and found not persuasive because Ali et al. specifically teach long form and short form of prolactin receptor cDNA synthesis comparison of sequence homology (region of highest homology (70%) is retained by the short form) between the two forms and the expressed short form in the Nb2 cells is missing 600 nucleotides compared to long form (see page 20112, Fig. 1, col. 1 paragraph 1 under results section). Further as pointed out by the Applicants, Examiner agrees that Fig. 4 is a schematic representation of the two forms of the prolactin receptor. However, Ali et al. disclose the synthesis of missing peptide (short form comprising missing region, (70% homology retained) by western blot analysis (see page 20112, col. 1, paragraph 3 under transient expression in COS-7 cells section) and characterization of the short form of the peptide (that is 198 amino acids smaller than the long form) (see page 20114, col. 2 paragraph 1, Fig. 7). Since the instant claim is in comprising format, "synthesizing a peptide having 70% homology" does not exclude the synthesis of short form of the peptide having 70% homology as taught by Ali et al. Further with regard to the testing or analyzing antagonizing effects of said peptide, Ali et al. analyzed the short form of the peptide and disclose that the short form of Nb2 cDNA encodes a protein that binds to prolactin receptor with a 3.3 fold higher affinity and have been characterized for the absence of consensus sequence (proline-rich cluster region) that is involved in signal transduction, which inherently indicates the antagonizing effect of the short form of prolactin. As noted in MPEP 2112, "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). In the instant context Ali et al. teach synthesis of missing region of prolactin receptor peptide (short form of prolactin receptor) and the antagonizing effect is the inherent property of the said protein. Therefore the disclosure of Ali et al. does anticipate the instant invention and the rejection is maintained.

With regard to the rejection under 35 USC 103(a), Applicants' arguments have been fully considered and found not persuasive. Applicants' argue that neither Ali et al. nor Kelly et al. disclose the synthesis of a peptide having at least 70% homology to the missing region and the activity of the said peptide as an antagonist to the ligand for the receptor. These arguments have been fully reviewed and found unpersuasive. As discussed above Ali et al. does disclose synthesis of missing peptide and thus it is obvious to one of the ordinary skill in the art to synthesize said peptide comprising 80% or 90% homology by chemical means as taught by Kelly et al. Therefore the rejection is maintained.